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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,686	07/27/2006	Adolf Zaiser	3743	8418

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STRIKER, STRIKER & STENBY  
103 East Neck Road  
Huntington, NY 11743

EXAMINER
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DEXTER, CLARK F

ART UNIT	PAPER NUMBER
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3724

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03/08/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/587,686	Applicant(s) ZAISER ET AL.	
	Examiner Clark F. Dexter	Art Unit 3724	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 4,7-14 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,15-20,22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The amendments filed on August 14, 2009 and October 26, 2009 have been entered.

### ***Election/Restrictions***

2. Newly submitted claim 21 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claim 21, Group V, is directed to a saw with the special technical feature of a specific bracing means material that is not required in any of the other groups.

Conversely, the special technical features of Groups I-IV are not required in Group V.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 21 along with claims 4 and 7-14 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3, 5, 6, 15-20, 22 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s)

Art Unit: 3724

contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not provide support for the recitation "the compiling means" as now set forth in claim 1, line 7.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-3, 5, 6, 15-20, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 6, the recitation "located between the saw blade" renders the claim vague and indefinite since the invention is being defined in terms of the saw blade which is not positively set forth as being part of the claimed invention (see claim 6); in line 7, the recitation "the compiling means" lacks antecedent basis and is vague and indefinite as to what disclosed structure it refers.

In claim 17, line 2, the recitation "project out" is vague and indefinite since it is not clear how a recess can project out of something; in lines 2-3, the recitation "bracing means of the contact face" is vague and indefinite as to what is being set forth (is it intended to mean "relative to"?).

In claim 18, lines 2-3, the recitation “at a reverse edge of the cutting edge” is vague and indefinite since it is not clear what structure is being set forth (e.g., the cutting edge is an edge and thus it is not clear as to what is the reverse edge thereof).

In claim 22, line 3, the recitation “facing the saw blade” renders the claim vague and indefinite since the invention is being positively defined in terms of the saw blade which is not positively set forth as part of the claimed invention.

In claim 23, the claim is vague and indefinite since the invention is being positively defined in terms of the saw blade which is not positively set forth as part of the claimed invention.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 and 5, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Godfrey et al., pn 3,155,128.

Godfrey discloses a handheld power saw with every structural limitation of the claimed invention as best understood from the claims including:

a coupling means (e.g., 80) for retaining and driving a saw blade and connecting the saw blade to a lifting rod (e.g., any of the rods disclosed thereby including 64) in an installed state of the saw blade, and a guide assembly (e.g., 88, 90) for guiding an

Art Unit: 3724

oscillating motion of the saw blade, wherein the guide assembly includes at least one lateral bracing means (e.g., see Fig. 5) located between the saw blade and the lifting rod in a region of the compiling means (e.g., as best understood, Godfrey discloses such a structure) and shielding the coupling means from shear forces acting on the saw blade;

[claim 2] wherein the bracing means is configured for bracing on both sides against shear forces on the saw blade;

[claim 3] wherein the bracing means is configured as a slide bearing;

[claim 5] wherein the bracing means forms a two-dimensional contact face;

[claim 15] wherein the guide assembly includes a pressure roller (e.g., 66, 74, 82), supported in sliding fashion on a bolt (e.g., one of 68, 72, 80), and a pressure bolt (e.g., the other of 68, 72, 80) for guiding the saw blade;

[claim 19] wherein two lateral bracing means are provided;

[claim 20 (from 19) wherein in an installed state of the saw blade the two lateral bracing means are located mirror-symmetrically beside the saw blade (e.g., each one of 88 and 90 includes lateral structures/portions/members that are integral with one another and are located mirror-symmetrically beside the saw blade).

### ***Claim Rejections - 35 USC § 102/103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3724

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 6 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Godfrey et al., pn 3,155,128.

Godfrey discloses a handheld power saw with every structural limitation of the claimed invention including:

[claim 6 (from 5)] characterized in that the contact face has a length of at least 2 cm in a longitudinal direction of the saw blade.

For example, providing the saw in a particular saw having the appropriate dimensions will result in the claimed contact face length.

In the alternative, if it is argued that Godfrey does not explicitly disclose the claimed length, to provide such a contact face length would be the mere discovery of the optimum or workable ranges within the general conditions of the prior art by routine experimentation and therefore obvious to one having ordinary skill in the art.

Art Unit: 3724

11. Claim 18 is rejected under 35 U.S.C. 102(b) as anticipated by Godfrey et al., pn 3,155,128 or, in the alternative, under 35 U.S.C. 103(a) as obvious over Godfrey et al., pn 3,155,128 in view of Odendahl et al., pn 5,644,847.

Godfrey discloses a handheld power saw with every structural limitation of the claimed invention including:

[claim 18 (from 15)] wherein the pressure roller (e.g., 82) guides the saw blade at a reverse edge of a cutting edge (e.g., as best understood).

In the alternative, if it is argued that the roller 82 is not capable of performing applicant's intended claimed function wherein applicant intends that the pressure roller contacts the blade, the Examiner takes Official notice that such pressure rollers are old and well known in the art and provide various well known benefits including stabilizing or bracing the movement of the saw blade, particularly when faced with forces applied during cutting. Odendahl discloses an example of such a pressure roller (e.g., see Figs. 5 and 7). Therefore, it would have been obvious to one having ordinary skill in the art to provide such a pressure roller on the saw of Godfrey to gain the well known benefits including those described above.

### ***Claim Rejections - 35 USC § 103***

12. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Godfrey et al., pn 3,155,128.

Godfrey discloses a handheld power saw with almost every structural limitation of the claimed invention but lacks the specific bracing means configuration as follows:

[claim 22] wherein the bracing means has a rounded area in a front region of the bracing means facing the saw blade.

However, the Examiner takes Official notice that it is old and well known in the art to provide such a rounded area for various well known benefits including to provide rounded edges to improve handling during assembly and to make insertion of associated components easier (i.e., the rounded areas provide a guide surface to facilitate insertion of the associated component). Therefore, it would have been obvious to one having ordinary skill in the art to provide such a rounded area in a front region of the bracing means of Godfrey to gain the well known benefits including those described above.

***Claims Not Rejected Over Prior Art***

13. Claims 16, 17 and 23 are considered to read over the prior art of record because the prior art or record does not teach or suggest the claimed combination of features including a compiling means in combination with “the bolt and the pressure bolt being inserted in recesses provided in the bracing means as set forth in claim 16, and in combination with the relationship between the bracing means and the saw blade as best understood from claim 23. However, these claims **cannot** be considered to be “allowable” at this time due to the rejection(s) under 35 U.S.C. 112, 1<sup>st</sup> paragraph set forth in this Office action. Therefore, upon the claims being rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action, further consideration of these claims with respect to the prior art will be necessary.

***Response to Arguments***

14. Applicant's arguments filed August 13, 2009 have been fully considered but they are not persuasive.

It is respectfully submitted that contrary to applicant's arguments directed to the prior art rejections over Godfrey, the amended claims continue to be anticipated by or rendered obvious over Godfrey as described in further detail above.

Regarding applicant's arguments in the third paragraph on page 11 of the subject response, the Examiner's position is that the relationship between the coupling means, the lifting rod and the saw blade are met by Godfrey. Further, regarding this paragraph and the paragraph bridging pages 11-12 of the subject response, it is respectfully submitted that the Examiner's position is not that Godfrey's device performs in the same manner as the disclosed invention, but that Godfrey teaches or fairly suggests all of the structure of the claimed invention.

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 3724

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/  
Primary Examiner, Art Unit 3724**

cfd  
March 1, 2010